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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,654	09/23/2003	Bruce F. Macbeth	905-075 CON	2073

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WALL MARJAMA & BILINSKI
101 SOUTH SALINA STREET
SUITE 400
SYRACUSE, NY 13202

EXAMINER	
DEB, ANJAN K	
ART UNIT	**PAPER NUMBER**
2858	

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/668,654	MACBETH, BRUCE F.	
	Examiner	Art Unit	
	Anjan K Deb	2858	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *30-67* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *30,35-37 and 51-66* is/are rejected.

7)☒ Claim(s) *31-34,38-50 and 67* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 65 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 29 of prior U.S. Patent No. 6,674,289 B2. This is a double patenting rejection.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 54-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,674,289 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,674,289 B2 (claims 18-28) discloses all of the claimed limitations.

4. Claims 30, 35-38, 51-53, 66 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,674,289 B2 in view of Neiger et al. (US 5,600,524).

Re claims 30, 66 U.S. Patent No. 6,674,289 B2 claimed (see claim 1) all of the limitations except an alarm circuit and generating an alarm signal if the step of attempting is a failure.

Neiger et al. disclose generating an alarm signal responsive to timing signal if the step of attempting is a failure (operational failure condition)(column 5 lines 10-21).

At the time of the invention it would have been obvious for one of ordinary skill in the art to modify U.S. Patent No. 6,674,289 B2 by adding an alarm signal responsive to timing signal disclosed by Neiger et al. for indicating operational failure condition.

Re claims 35-36, 51 U.S. Patent No. 6,674,289 B2 claimed (see claim 4) means for indicating fault in protection device.

Re claim 37, U.S. Patent No. 6,674,289 B2 claimed (see claim 8) first predetermined half-cycle bypass.

Re claim 38, U.S. Patent No. 6,674,289 B2 claimed (see claim 9) detection signal is produced during second predetermined half cycle of AC power.

Re claim 52, U.S. Patent No. 6,674,289 B2 claimed (see claim 9) timer circuit (checking circuit) is coupled to a power supply that operates independently from a remaining portion of the protection device.

Re claim 53, U.S. Patent No. 6,674,289 B2 claimed (see claim 17) protection device is one of a GFCI device, a GFEP device, and an AFCI device.

Allowable Subject Matter

5. Claims 31-34, 38-50, 67 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 31 is allowable because prior art does not teach or fairly suggest alarm circuit includes a ringing circuit configured to produce a ringing signal in response to detecting the detection signal.

Claims 32-34 are allowable because prior art does not teach or fairly suggest interrupter coupled to alarm circuit, to decouple plurality of line terminals from plurality of load terminals in response to alarm signal, the alarm signal being generated during a second predetermined half cycle of AC power.

Claims 38-50 are allowable because prior art does not teach or fairly suggest detector produces the detection signal during a second predetermined half-cycle of the AC power when a non-simulated fault is detected by the detector.

Claim 67 is allowable because prior art does not teach or fairly suggest the step the step of generating includes tripping the protection device on a positive half-cycle of AC power.

Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Anjan K. Deb whose telephone number is 571-272-2228. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, N. Le, can be reached at (571) 272-2233.

Anjan K. Deb
Patent Examiner
Art Unit: 2858
7/9/04

Tel: 571-272-2228
Fax: 571-273-2228
E-mail : anjan.deb@uspto.gov